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ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
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OFFICE OF PETITIONS

In re Application of
Mori et al.
Application No. 09/320,649
Filed: May 27, 1999
Attorney Docket No. P725-9009

ON PETITION

This is a decision on the petition, filed February 23, 2007¹, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition to withdraw the holding of abandonment is **Dismissed**.

Any request for reconsideration should be filed within **TWO MONTHS** of the mailing date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136.

This application was held abandoned for failure to reply to the non final Office action mailed on April 11, 2001, which set a three (3) month shortened statutory period for reply. The non final Office action was re-mailed on April 26, 2001. A Notice of Abandonment was mailed on March 29, 2002.

Petitioner asserts that the Office action dated April 26, 2001 was not received. Petitioner contends that the Office Action was not received because the change of correspondence address was not entered by the Office.

¹It is noted that this petition is a duplicate copy of a previously submitted petition dated October 23, 2006.

Petitioner's argument has been considered but it is not convincing to establish the holding of abandonment should be withdrawn. The non final Office Action was mailed on April 11, 2001 to the then correspondence address of record (Nikaido Marmelstein Murray & Oram at Metropolitan Square 330-G Street Lobby, Washington DC 20005). The Office action was returned to the Office because the correspondence was undeliverable as addressed. The correspondence address of record was updated on April 26, 2001.² The Office action was re-mailed to correspondence address Nikaido Marmelstein Murray & Oram at Metropolitan Square 665 15th Street, N.W. 330-G Street Lobby, Washington, DC 20005. The non-final Office action mailed on April 26, 2001 was returned to the Office because it was undeliverable as addressed and the forwarding order expired.

Petitioner has failed to state or provide evidence that a change of correspondence address was filed in the Office prior to May 22, 2001. Where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address does not constitute unavoidable delay. See MPEP 711.03(c). Nor would the failure to promptly change the correspondence address allow for withdrawing the holding of abandonment. To the extent petitioner contends that a request to change the correspondence address prior to May 22, 2001 was submitted, evidence to that effect should be provided.

The submission of the change of correspondence address via customer number 4372 was filed on May 22, 2001 over a month after the re-mailing of the non-final Office action. The Notice of Abandonment was mailed on March 29, 2002. The evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment.

²There is no indication that a change of correspondence address was entered as a result of customer request.

See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

If petitioner cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$ 770.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Any renewed petition or petition under 37 CFR 1.137 must include a statement as to the five year (July 27, 2001 thru October 23, 2006) delay in filing a petition to revive.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile:

(571) 273-8300

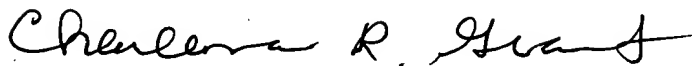
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Telephone inquiries concerning this matter should be directed to the undersigned at
(571) 272-3215.

A handwritten signature in cursive script, reading "Charlema R. Grant". The signature is written in black ink and is positioned above the printed name and title.

Charlema R. Grant

Petitions Attorney

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